## DETAILED ACTION

Applicant's response of June 30, 2009 has been fully considered. Claim 1 has been amended and claim 5 has been added. Claims 1-5 are pending.

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanji et al. (US 2002/0114773).

Regarding claims 1 and 5, Kanji et al. teaches a composition containing at least one film forming silicone resin chosen from siloxysilicates (MQ resins) and silsesquioxanes (¶54). Kanji et al. states that as used in the specification, the expression "at least one" means one or more and thus includes individual components as well as mixtures and combinations (¶1). By this definition, Kanji et al. teaches that the silicone resin of the composition could be comprised of two resins, a siloxysilicate and a silsesquioxane.

Siloxysilicates (the MQ resin) used in the composition are exemplified by trimethylsiloxysilicates, which are represented by the following formula: $[(CH_3)_3—Si—O]_x—(SiO_{4/2})_y$ (MQ units) where x and y can have values ranging from 50 to 80 (¶64). A siloxysilicate may also be chosen from any combination of M and Q units, such as, for example, $[(R)_3—Si—O]_x—(SiO_{4/2})_y$, where R is chosen from a methyl group and longer carbon chains (¶64). The entire resin can be made of MQ units giving at least 80 mole % of them.

Silsesquioxanes used in the composition are represented by the following formula: $(CH_3SiO_{3/2})_x$ where x has a value of up to several thousand and the $CH_3$ may be replaced (¶65) by a longer carbon chain such as an ethane, propane, or butane (¶63), therefore teaching the claimed propyl Silsesquioxane resin. All of the $CH_3$ groups could be replaced with propane giving at least 40 mole % of the substituted groups being propyl. Additionally, the entire resin can be made of $(CH_3SiO_{3/2})_x$ units giving at least 80 mole % of them.

Kanji et al. additionally teaches the presence of volatile siloxanes in the composition (¶96).

Kanji et al. does not teach that the weight ratio of two resins in a mixture is from 90:10 to 10:90, or more specifically 85:15 to 15:85. However, when faced with a mixture, one of ordinary skill in the art would be motivated by common sense to select a 1:1 ratio, a ratio that falls within the presently claimed amount, absent evidence of unexpected or surprising results. Case law holds that "[h]aving established that this knowledge was in the art, the examiner could then properly rely... on a conclusion of obviousness, 'from common knowledge and common sense of the person of ordinary skill in the art within any specific hint or suggestion in a particular reference." *In re Hoeschele*, 406 F. 2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969). ("The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, in the prior art as a whole, or the nature of the problem itself." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)).

Kanji et al. does not teach the specific combination of the above resins in the resin composition. However, at the time of the invention, a person of ordinary skill in the art would have been motivated to pick these two types of film-forming resins and combine them as part of a composition because they each bring different properties to the composition (i.e., the MQ resins are typically harder while the silsesquioxanes are generally continuous and flexible) and combining them can help maximize transfer resistant properties as well as pliability, softness and wearing comfort of the composition.

Regarding claims 2-4, Kanji et al. additionally teaches personal care products such as cosmetics and hair care products (¶12).

### *Response to Arguments*

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/A. C. S./
Examiner, Art Unit 1796